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IN THE
Supreme Court of the United States

OCTOBER TERM, 1944.

No. 1084

KRAFT CHEESE COMPANY,

Petitioner,

vs.

CONWAY P. COE, COMMISSIONER OF PATENTS,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA.

PETITIONER'S REPLY TO RESPONDENT'S BRIEF.

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Attorney for Petitioner.

April 30, 1945.



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Item 1,—The District Court's Findings.

On page 4 of Respondent's Brief, paragraphs 4 and 5 of the District Court's findings are quoted, and Respondent says: "The Court below accepted and relied upon these findings of fact in reaching its decision. (R. 52.)"

Plaintiff-Petitioner challenged paragraph 5 (See R. 39) on the ground that there was no evidence to support the same, and this point was argued in the Court of Appeals. An examination of the Court of Appeals' decision (R. 52) shows that the sole ground relied upon for refusing relief is included in paragraph 4 of the findings, *i. e.*, that

"Old" is descriptive, and "English" is geographical. The Court of Appeals decision contains no reference to paragraph 5 of the District Court's findings.

Item 2,—Secondary Significance.

Petitioner freely admits that, under the 1905 act, any mark which, as an entirety, has a descriptive or a geographical meaning, cannot be registered unless it was used prior to 1905 and thus qualifies under the ten-year proviso. Throughout this proceeding, Petitioner has never relied solely upon the fact that its mark has acquired a secondary significance by reason of its use since the year 1912. In this respect, the Court of Appeals and Respondent's counsel have misconstrued Petitioner's argument.

Petitioner's position is that the mark is registrable because it is inherently a fanciful mark in its entirety, and that, in its entirety, it is neither descriptive, nor is it geographical. As to the *Hamilton Brown Shoe Company v. Wolf Bros.* case, 240 U. S. 251, it is true that registration under the 1905 Act was not involved, but, in determining what recovery should be allowed, the Defendant argued that "American Girl" was not a good technical, common law trade-mark and that the damages should be limited under the unfair competition theory of palming off, based upon secondary significance. Thus, the question of whether the mark "American Girl" was a good technical mark was directly presented to the Supreme Court, which held that it was a legitimate trade-mark.

As pointed out in our main brief (p. 9), it was the intention of Congress to permit the registration of all technical or legitimate common law trade-marks. Therefore, the sole question here is whether the mark "Old English" is, or is not, a good, legitimate, common law trade-mark. If "American Girl" is inherently a good, legitimate trade-

mark, so should be "Old English." No question of secondary significance is involved.

In the "Old South" case, also referred to on page 7 of Respondent's Brief, it is true that, in the majority decision, secondary significance due to use in a specific territory is mentioned, but the use was very slight. It was neither extensive nor long continued, in fact so short (only eight months) that it is difficult to see how the case could have been controlled by it.

Regardless of the reasons for the "Old South" decision, the fact is that, since that decision, the Patent Office has registered the mark "Old South" under the 1905 Act. (R. 47, 48.)

Item 3,—English Dairy.

At the foot of page 5 of his brief, Respondent refers to Agriculture Bulletin No. 608. This Bulletin is not in evidence. It was quite unnecessary for Respondent to go outside of the record. Petitioner's witness, Kraft (Rec. 32), testified fully and frankly about this so-called "English Dairy" cheese, a type which has been made in the United States in small quantities and is now practically extinct.

We cannot see how the use of the words "English Dairy," as applied to a type of cheese made in this country, can have any possible bearing upon Petitioner's right to register the mark "Old English" in its entirety. Petitioner is not seeking to register the word "English" separately from the composite mark. In fact, the exclusive use of the word "English" has been disclaimed, from the inception of this proceeding.

Item 4,—The 1920 Act.

At the foot of page 11, in the footnote, Respondent repeats the suggestion, originally made by the Patent Office, that the mark could be registered under the 1920 Act, which permits the registration of descriptive or geographical marks. But to do so would require the Petitioner to admit that its mark, as an entirety, is either geographical or descriptive. Such an admission might furnish an unscrupulous competitor with a made-to-order, plausible excuse for imposing upon the public by imitating a mark which he would not dare infringe upon, if it had been registered under the Act of 1905. Such a 1920 registration might brand Petitioner's mark with a stigma from which it might never recover.

We submit that the 1920 Act was not passed by Congress for the purpose of supplying the Commissioner of Patents with a convenient waste basket in which to dispose of troublesome cases, or to serve as an excuse for resolving all questions against an Applicant under the 1905 Act.

Respectfully submitted,

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April 30, 1945.

